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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,707	06/05/2001	Dan Kikinis	ISURFTV137	7928

52940 7590 10/04/2006

TODD S. PARKHURST
HOLLAND & KNIGHT LLP
131 S. DEARBORN STREET
30TH FLOOR
CHICAGO, IL 60603

EXAMINER

SALTARELLI, DOMINIC D

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/875,707	Applicant(s) KIKINIS ET AL.	
	Examiner Dominic D. Saltarelli	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

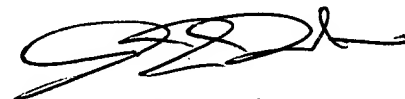
1. In view of the Appeal Brief filed on July 10, 2006, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton et al. (5,831,664) [Wharton] in view of Terkado et al. (6,311,329) [Terakado] and Stautner et al. (6,172,677) [Stautner].

Regarding claims 1, 9, and 17, Wharton discloses an entertainment system (figs. 1 and 2) comprising:

a unit to transmit information and to receiving information via a wireless connection (figs. 1 and 2, settop box 16);

a plurality of hand held devices capable of simultaneously communicating with said unit (PDAs 12 shown in fig. 2), wherein each apparatus comprises a control unit to interact with an application (col. 1 line 60 – col. 2 line 10 and col. 3 line 25 – col. 4 line 36).

Wharton fails to disclose the application is an electronic program guide (EPG) and an indicator to indicate availability of an interactive function in a program corresponding to the EPG.

In an analogous art, Terakado teaches it was well known to use handheld devices to conveniently view program guide information (col. 5, lines 46-57).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Wharton to use the handheld devices to view an EPG. The suggestion to do so is found in Wharton, col. 1, lines 27-59, who teaches, when describing the problem his invention address, the limitations of current television applications is due largely to the limitations of the remote

control devices used by viewers, and foremost of television applications is the EPG.

Wharton and Terakado fail to disclose an indicator to indicate availability of an interactive function in a program corresponding to the EPG.

In an analogous art, Stautner teaches an EPG that includes indicators to indicate availability of interactive functions in programs corresponding to the EPG (fig. 2), providing an enhanced EPG with improved flexibility in providing access to information to users (col. 3 line 30 – col. 4 line 9).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Wharton and Terakado to include an indicator to indicate availability of an interactive function in a program corresponding to the EPG, as taught by Stautner, for the benefit of providing an enhanced EPG with improved flexibility in providing access to information to users.

Regarding claims 2, 10, and 18, Wharton, Terakado, and Stautner disclose the system of claims 1, 9, and 17, wherein the indicator is displayed on a display of the apparatus (screen of the PDA, see Wharton, figs. 3a-f).

Regarding claims 3, 4, 7, 11, 12, 15, 19, 20, and 23, Wharton, Terakado, and Stautner disclose the system of claims 1, 2, 9, 10, 17, and 18, but fail to disclose the display changes background colors (flashes) or generates a sound

to indicate the availability of the interactive function in the program corresponding to the EPG.

Examiner takes official notice that it is notoriously well known in the art to change the colors of a displayed background in order to draw a viewer's attention to an object or occurrence of interest.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Wharton, Terakado, and Stautner to include the display changes background colors or generates a sound, such as a beep or chime, to indicate the availability of the interactive function in the program corresponding to the EPG, as these is a conventional method used draw a viewer's attention.

Regarding claims 5, 13, and 21, Wharton, Terakado, and Stautner disclose the system of claims 1, 9, and 17, wherein the apparatus is a personal digital assistant (Wharton, fig. 1, PDA 12).

Regarding claims 6, 14, and 22, Wharton, Terakado, and Stautner disclose the system of claims 1, 9, and 17, wherein the apparatus is a web phone (Wharton teaches the PDA is an Apple Newton, col. 3, lines 26-54, a device capable of both telephonic communications and Internet access).

Regarding claims 8, 16, and 24, Wharton, Terekado, and Stautner disclose the system of claims 1, 9, and 17, wherein the indicator is a section of the apparatus that illuminates to indicate the availability of the interactive function in the program corresponding to the EPG (displayed icons are illuminated sections of a display, Stautner, col. 6, lines 8-24).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

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Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. () _____ - _____ on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DS



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600